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PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

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Appeal No. _____

In re Application of: MICHAEL D. BULLOCK ET AL.
Serial No.: 09/735,002
Filed: December 12, 2000
For: PRACTICE PUTTER AND HEAD

APPELLANTS' BRIEF ON APPEAL

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS**

In re Application of: MICHAEL D. BULLOCK ET AL : Date: August 21, 2003
Serial No.: 09/735,002 :
Filed: December 12, 2000 : Group Art Unit: 3711
For: PRACTICE PUTTER AND HEAD :
: Examiner: Thanh P. Duong

APPELLANT'S BRIEF ON APPEAL

Commissioner of Patents and Trademarks
Washington, D. C. 20231

Sir:

This is Appellants' brief on appeal from the decision of the Examiner in the Office Action dated March 19, 2003 finally rejecting Claims 1-16 in the above-identified patent application. This brief is submitted in accordance with the provisions of 37 C.F.R. §1.192.

REAL PARTY IN INTEREST

The real party in interest are the inventors, Michael D. Bullock and Jeffrey G. Bullock.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to appellants, appellant's legal representative, or the assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-16 are currently pending in this application and were finally rejected in the Office Action dated March 19, 2003. Appellant appeals from this final rejection.

STATUS OF AMENDMENTS

With regard to the status of amendments, three Office Actions were issued during prosecution of this application. No claim amendments were made in response to the final Office Action dated March 19, 2003. The Claims as they currently stand are presented in the Appendix.

SUMMARY OF INVENTION

The present invention provides for a putter (10) and putter head (20) for use during putting practice. The practice putter(10) is used to improve a golfer's ability to contact a golf ball on the sweet spot of the putter. The practice putter (10) has a grip (12) and a shaft (11) as

in conventional putters. The shaft (11) is connected to a putter head (20) that is specifically designed to be used during practice and that has a design that will improve the golfer's ability to contact the golf ball on the sweet spot of the putter head.

The putter head (20) has a generally flat base (11) with an upwardly extending front surface having a relatively small, centrally-located, flat ball contact surface (23) that comprises the sweet spot of the putter head (20). The remainder of the front surface of the putter head (20) tapers away from the flat ball contact surface (23) toward the rear of the putter head (20). The tapered portions of the front surface, or ball contact surface (23) of the putter head may be flat or curved, but in any event are angled with respect to a normal to the flat ball contact surface (23).

An exemplary putter head (20) has lateral portions (24) that are relatively thick that each have openings (26, 26a) formed therein that receive the shaft (11). Thus, the practice putter (10) may be made so that it is either left or right handed. The rear portion of the exemplary putter head has a cavity (7) formed therein that reduces the overall weight of the putter head (20).

ISSUES

There are four issues in this appeal which are as follows.

The first issue is whether Claims 1, 2, 4, 5, 6, 9, 10, 12, 13 and 14 are unpatentable under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 3,489,415 issued to Smith in view of US Patent No. 5,135,228 issued to Hawkins, Sr.

The second issue is whether Claims 7 and 15 are unpatentable under 35 U.S.C. § 103 (a) as being unpatentable over US Patent No. 3,489,415 issued to Smith in view of US Patent No. 5,135,228 issued to Hawkins, Sr. in view of US Patent No. 6,402,638 issued to Kelly and US Patent No. 4,121,833 issued to Prueter.

The third issue is whether Claims 7 and 15 are unpatentable under 35 U.S.C. § 103 (a) as being unpatentable over US Patent No. 3,489,415 issued to Smith in view of US Patent No. 5,135,228 issued to Hawkins, Sr. and further in view of US Design Patent No. D234,962 issued to Swash.

The fourth issue is whether Claims 3, 8, 11 and 16 are unpatentable under 35 U.S.C. 103 (a) as being unpatentable over US Patent No. 3,489,415 issued to Smith in view of US Patent No. 5,135,228 issued to Hawkins, Sr. and further in view of US Patent No. 5,388,832 issued to Hsu.

GROUPING OF CLAIMS

With regard to the specific grounds of rejection that are in issue, it is respectfully submitted that Claims 1-16 stand or fall together.

ARGUMENT

With regard to the first issue, Claims 1, 2, 4, 5, 6, 9, 10, 12, 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 3,489,415 issued to Smith

in view of US Patent No. 5,135,228 issued to Hawkins, Sr. It is respectfully submitted that the present invention is not obvious in view of the Smith and Hawkins, Sr. patents, taken singly or together.

The Smith patent discloses a "practice attachment for a golf putter having a ball engaging face of substantially trapezoidal shape in section and including a base face portion and side face portions intersecting the base face portion at obtuse angles, there being wing portions extending from the attachment for engagement with strips of pressure sensitive tape to removably secure the attachment to the putting face removably with the base face portion parallel to the putting face." The Examiner stated with regard to the Smith patent that "it appears that the body having a front surface with a relatively small, centrally-located flat ball contact surface that comprises a sweet spot of the putter head."

It is therefore respectfully submitted that the Smith patent discloses a putting device wherein an attachment is secured to the putting face of a putter head using strips of pressure sensitive tape. The Smith attachment thus converts a conventional putter into a practice putter by means of the attachment. It is respectfully submitted that there is no disclosure or suggestion in the Smith patent regarding a unitary putter head comprising a single, solid, unitary body that is attached to a putter shaft.

The Hawkins, Sr. patent states that it discloses "a system for improving ones golf game by using a practice club with a very small head to hit practice balls that are light weight and preferably are very small in diameter. The novel practice golf club has a head or ball-hitting surface which is much smaller than a conventional golf club, such as either surface having a width of about 3.5 cm (1.4 in.) or less or even about 1.5 cm (0.6 in.) or less or a convex surface having a radius of less than about 1.25 cm (0.5 in.) or even about 0.8 cm (0.3 in.) or less. The practice balls are much lighter and preferably smaller than a conventional golf ball, such as less than about 30 g, for example about 1.9 cm (0.75 in.) in diameter and about 1.5 g or about 1.27 cm (0.5 in.) in diameter and about 1 g. This invention includes as optional components of the system mat means and net means. The invention can be embodied in the form of an adaptor to convert a conventional golf club to have the type of ball-hitting surface described above."

Thus, it is respectfully submitted that the Hawkins, Sr. patent discloses an attachment or adaptor for converting a conventional golf club to a practice club. The Hawkins, Sr. patent does not disclose or suggest anything regarding putting or a practice putter. [Emphasis added] It is respectfully submitted that there is no disclosure or suggestion in the Hawkins, Sr. patent regarding a unitary putter head comprising a single, solid, unitary body that is attached to a putter shaft. No putting devices are discussed in the Hawkins, Sr. patent.

It is respectfully submitted that both the Smith or Hawkins, Sr. patents disclose devices that attach to existing clubs that adapt the club for another purpose. It is respectfully submitted that the prior art attachments are not permanent and are not immovable as is the present invention. The attachments of the prior art are not permanent and provide for possible

alignment problems and are not necessarily stable. It is respectfully submitted that the prior art devices do not provide for a permanent sweet spot on a putter.

It is respectfully submitted that the Smith and Hawkins, Sr. patents are essentially nonanalogous art with regard to the present invention. The presently claimed invention calls for a unitary putter head comprising a single, solid, unitary body that is attached to a putter shaft. None of the devices disclosed or suggested by the Smith or Hawkins, Sr. patents are a putter head comprising a single, solid, unitary body.

The essence of the present invention is that it allows a user to practice putting with a device that has a permanent, nonmoving, sweet spot. This is not the case with the Smith and Hawkins, Sr. attachment devices which are attached by various means that do not provide for a unitary structure nor would they necessarily provide for a permanent sweet spot, nor do they insure that the sweet spot is properly located or permanent.

Therefore, with specific regard to independent Claim 1, it is respectfully submitted that the Smith or Hawkins, Sr. patents, taken singly or together, do not disclose or suggest a putter head that comprises "a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface that comprises a sweet spot of the putter head and lateral portions that taper rearwardly away from the ball contact surface".

With regard to independent Claim 9, and in view of the above arguments, it is respectfully submitted that the Smith or Hawkins, Sr. patents, taken singly or together, do not disclose or suggest a putter head that comprises "a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface that comprises a sweet spot of the putter head and lateral portions that taper rearwardly away from the ball contact surface".

In summary, it is respectfully submitted that the cited references each disclose attachments for a golf club and do not disclose or suggest a unitary putter head comprising a single, solid, unitary body that is attached to a putter shaft. None of the devices disclosed or suggested by the Smith or Hawkins, Sr. patents provide for a putter head comprising a single, solid, unitary body.

During prosecution, the Examiner raised a number of specific issues, which will be addressed below.

With respect to the limitation "single, solid, and unitary body", the Examiner has argued that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to either fabricate the front surface with a relatively small, centrally-located, and flat sweet spot as an attachment or as an integral piece of the practice putter head, since it has been held that forming one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. Howard v. Detroit Stove Works, 150 U.S. 164 (1893) and Nerwin v. Erlichman, 168 USPQ 177, 179."

However, it is respectfully submitted that converting either of the devices disclosed in the Smith and Hawkins, Sr. patents does not amount to forming a one piece article which has formerly been formed in two pieces and put together, as is suggested by the Examiner.

The Smith device is constructed using three separate elements. These are a conventional putter, a practice attachment, and strips of pressure sensitive tape disposed between the putter and practice attachment to secure them together. It is respectfully submitted that the construction of the Smith practice putter is not formed using two pieces, there are three pieces. Furthermore, it is respectfully submitted that the Smith practice putter cannot be formed into a single unitary structure without removing the strips of pressure sensitive tape, which is not disclosed or suggested by the Smith patent. Such a modification of the Smith device would amount to hindsight reconstruction on the part of the Examiner.

It is respectfully submitted that the Hawkins, Sr. patent discloses an attachment or adaptor for converting a conventional golf club to a practice club. The Hawkins, Sr. patent does not disclose or suggest anything regarding putting or a practice putter.

The Hawkins, Sr. practice attachment includes an attachment or adaptor that is secured to a golf club head by means of straps. As is the case with the Smith, the Hawkins, Sr. device is constructed using three separate elements. These are a conventional golf club (not a putter), an attachment, and two straps attached to the attachment that wrap around the golf club head to secure the attachment thereto. Thus, it is respectfully submitted that the construction of the Hawkins, Sr. practice club is not formed using two pieces, there are three pieces.

Furthermore, it is respectfully submitted that the Hawkins, Sr. practice club cannot be formed into a single unitary structure without removing the two straps that are attached to the attachment, which is not disclosed or suggested by the Hawkins, Sr. patent. Such a modification of the Hawkins, Sr. golf club and attachment amounts to hindsight reconstruction on the part of the Examiner.

Therefore, and in view of the above, the purported holdings of the Howard v. Detroit Stove Works and Nerwin v. Erlichman cases cited by the Examiner are not on point when applied to the rejection of the present invention in view of the Smith and Hawkins, Sr. patents. It is respectfully submitted that the Examiner's rejection is based upon distortion and extension of the teachings of the Smith and Hawkins, Sr. patents in light of Applicant's own teachings. The only disclosure of a practice putter having a single, solid, unitary body is found in the present application, and cannot be derived from the teachings of the prior art references without using hindsight reconstruction.

In the "Response to Arguments" section of the final Office Action, it is stated that "Smith 415' in view of Hawkins, Sr. 228' clearly show a practice putter where a conventional putter is converted into a practice putter. Such feature is desirable because the user does not have to carry two separate putters, a conventional putter and a practice putter similar to the Applicant's invention. Thus, Smith in view of Hawkins, Sr. invention's clearly came up a novel

idea of converting a conventional putter into a practice putter with a practice attachment, which allows a user to carry one putter and its practice attachment."

It is respectfully submitted that these statements are clearly indicative of the fact that the present invention is not similar to, nor is it obvious in view of, the teachings of the Smith and Hawkins, Sr. patents. The present invention is not a "conventional putter" that is "converted into a practice putter," as the Examiner asserts, it is a single unitary practice device that is separate and distinct from a normal putter used during a golf round.

The Examiner stated in the Advisory Action issued n this application that the request for reconsideration was considered but does not place the application in condition for allowance because "Smith '415 in view of Hawkins, Sr. '228 suggests and/or teaches the claimed invention as stated in the final action. Applicant's argument is merely that there is no 102., i.e. no one reference anticipating the invention. That is not the rejection."

It is respectfully submitted that Applicants argued the fact that the combined teachings of the Smith and Hawkins, Sr. patents do not disclose or suggest the present invention as claimed. The Examiner has apparently misread or misunderstood what was stated in the Response dated March 4, 2003.

Each of the cited patents was discussed with regard to the fact that they disclose attachments for a golf clubs and do not disclose or suggest a unitary putter head comprising a single, solid, unitary body that is attached to a putter shaft. None of the devices disclosed or suggested by the Smith or Hawkins, Sr. patents provide for a putter head comprising a single, solid, unitary body. Therefore, it is clear that the combined teachings of these references do not disclose or suggest the presently claimed unitary putter head.

With regard to the § 103 rejection, as it pertains the pending independent Claims, what was stated in the Response dated March 4, 2003 is that:

"... with specific regard to independent Claim 1, it is respectfully submitted that the Smith or Hawkins, Sr. patents, taken singly or together, do not disclose or suggest a putter head that comprises "a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface that comprises a sweet spot of the putter head and lateral portions that taper rearwardly away from the ball contact surface".

Therefore, it is respectfully submitted that Claim 1 is not obvious in view of the Smith or Hawkins, Sr. patents, taken singly or together. Accordingly, withdrawal of the Examiner's rejection and allowance of Claim 1 are respectfully requested.

With regard to independent Claim 9, and in view of the above arguments, it is respectfully submitted that the Smith or Hawkins, Sr. patents, taken singly or together, do not disclose or suggest a putter head that comprises "a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface that comprises a sweet spot of the putter head and lateral portions that taper rearwardly away from the ball contact surface".

It is respectfully submitted that these statements clearly address the § 103 obviousness rejection and not the § 102 rejection suggested by the Examiner. The fact that the teachings of each patent were separately discussed is not the issue. Since neither of the cited patents

disclose or suggest a unitary putter head, it necessarily follows that the combined teachings of the cited patents do not disclose or suggest a unitary putter head.

Therefore, and in view of the above arguments, it is respectfully submitted that Claims 1 and 9 are not obvious in view of the Smith or Hawkins, Sr., taken singly or together. Accordingly, reversal of the Examiner's rejection and allowance of Claims 1 and 9 are respectfully requested.

Dependent Claims 2, 4, 5, 6, 10, 12, 13 and 14 are considered patentable over the Smith or Hawkins, Sr. patents, taken singly or together, based upon the allowability of Claims 1 and 9. Accordingly, reversal of the Examiner's rejection and allowance of Claims 2, 4, 5, 6, 10, 12, 13 and 14 are respectfully requested.

With regard to the second issue, Claims 7 and 15 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over US Patent No. 3,489,415 issued to Smith in view of US Patent No. 5,135,228 issued to Hawkins, Sr. in view of US Patent No. 6,402,638 issued to Kelly and US Patent No. 4,121,833 issued to Prueter. The Examiner cited the Kelly and Prueter patents as disclosing a shaft inserted into the practice putter head. In particular, with regard to the Kelly patent, the Examiner's position is that "Kelly shows a practice putter (Figs. 1 and 2) with a top surface 30 having a thick lateral ends with a hole 40 to receive an end of the shaft 18." With regard to the Prueter patent, the Examiner's position is that "Prueter also shows (Figs. 17-22) a golf club with a top surface 54 having a thick lateral bases 55 and 56 with a shaft 48 inserted into a bore 51."

It is respectfully submitted that none of the four cited patents, taken singly or together, disclose or suggest the inventions recited in Claims 1 and 9. It is therefore respectfully submitted that Claims 7 and 15 are patentable over the cited patents, taken singly or together, based upon the patentability of Claims 1 and 9. Reversal of the Examiner's rejection and allowance of Claims 7 and 15 are respectfully requested.

With regard to the third issue, Claims 7 and 15 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over US Patent No. 3,489,415 issued to Smith in view of US Patent No. 5,135,228 issued to Hawkins, Sr. and further in view of US Design Patent No. D234,962 issued to Swash. The Examiner cited the Swash patent as disclosing a shaft inserted into the practice putter head.

It is respectfully submitted that neither of the cited patents, taken singly or together, disclose or suggest the inventions recited in Claims 1 and 9. It is therefore respectfully submitted that Claims 7 and 15 are patentable over the cited patents, taken singly or together, based upon the patentability of Claims 1 and 9. Reversal of the Examiner's rejection and allowance of Claims 7 and 15 are respectfully requested.

With regard to the fourth issue, Claims 3, 8, 11 and 16 were rejected under 35 U.S.C. 103 (a) as being unpatentable over US Patent No. 3,489,415 issued to Smith in view of US Patent No. 5,135,228 issued to Hawkins, Sr. and further in view of US Patent No. 5,388,832

issued to Hsu. The Examiner cited the Hsu patent as disclosing "a shaft 10 that has an offset and is inserted into the neck 16".

It is respectfully submitted that none of the cited patents, taken singly or together, disclose or suggest the inventions recited in Claims 1 and 9. It is therefore respectfully submitted that Claims 3, 8, 11 and 16 are patentable over the cited patents, taken singly or together, based upon the patentability of Claims 1 and 9. Reversal of the Examiner's rejection and allowance of Claims 3, 8, 11 and 16 are respectfully requested.

In summary, it is respectfully submitted that none of the prior art patents cited by the Examiner, taken singly or together, disclose or suggest a putter head having a single, solid, unitary body. Therefore, with specific regard to independent Claim 1, it is respectfully submitted that the Smith or Hawkins, Sr. patents, taken singly or together, do not disclose or suggest a putter head that comprises "a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface that comprises a sweet spot of the putter head and lateral portions that taper rearwardly away from the ball contact surface".

With regard to independent Claim 9, and in view of the above arguments, it is respectfully submitted that the Smith or Hawkins, Sr. patents, taken singly or together, do not disclose or suggest a putter head that comprises "a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface that comprises a sweet spot of the putter head and lateral portions that taper rearwardly away from the ball contact surface".

It is also respectfully submitted that any modification of the Smith or Hawkins, Sr. apparatus to create a unitary structure amounts to hindsight reconstruction on the part of the Examiner, based upon the teachings of the present application.

In view of the above, it is respectfully submitted that Claims 1-16 are not obvious in view of the cited patents, taken singly or in combination, and are therefore patentable. Therefore, it is respectfully submitted that the rejection of Claims 1-16 by the Examiner was erroneous, and reversal of the Examiner's decision is respectfully requested.

Respectfully submitted,



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APPENDIX

Claims 1-16 presented below are currently pending in this application.

1. A putter comprising:
a shaft having a grip disposed at an upper end;
a putter head disposed at a lower end of the shaft that comprises:
a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface that comprises a sweet spot of the putter head and lateral portions that taper rearwardly away from the ball contact surface.
2. The putter recited in Claim 1 wherein the shaft is straight.
3. The putter recited in Claim 1 wherein the shaft has an offset.
4. The putter recited in Claim 1 wherein the body has a trapezoidal shape.
5. The putter recited in Claim 1 wherein the lateral portions of the front surface are flat surfaces.
6. The putter recited in Claim 1 wherein the lateral portions of the front surface are curved surfaces.
7. The putter recited in Claim 1 wherein the putter head has a flat base with relatively thick lateral ends, one of which has an opening therein into which the shaft is inserted.
8. The putter recited in Claim 7 wherein a rear portion of the putter head has a cavity formed therein.
9. In a putter having a shaft with a grip disposed at an upper end and a putter head disposed at a lower end, wherein the putter head comprises:
a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface that comprises a sweet spot of the putter head and lateral portions that taper rearwardly away from the ball contact surface.
10. The putter head recited in Claim 9 wherein the shaft is straight.
11. The putter head recited in Claim 9 wherein the shaft has an offset.

12. The putter head recited in Claim 9 wherein the body has a trapezoidal shape.
13. The putter head recited in Claim 9 wherein the lateral portions of the front surface are flat surfaces.
14. The putter head recited in Claim 9 wherein the lateral portions of the front surface are curved surfaces.
15. The putter head recited in Claim 9 which has a flat base with relatively thick lateral ends, one of which has an opening therein into which the shaft is inserted.
16. The putter head recited in Claim 15 which further comprises a cavity formed in a rear portion thereof.